

REMARKS

Applicant has carefully studied the final action and submits the following response. In the response, all of the claims are canceled and new claims are added. The new claims are believed to be in condition for allowance for all of the following reasons.

Rejection of claims 4, 5, and 7-11 as obvious over Berlowitz, alone or in view of Bacha

The examiner maintained the rejection of claims 4, 5, and 7-11 as obvious over U.S. Patent No. 6,663,767 to Berlowitz, ("Berlowitz") alone, or in combination with U.S. Patent No. 6,766,897 to Bacha ("Bacha").

Response

Claims 4, 5, and 7-11 have been canceled and new claims 12-42 have been added. The examiner cannot establish a case of *prima facie* obviousness of new claims 12-42 over Berlowitz in view of Bacha.

As explained in the specification, "[t]ypical diesel fuels comprise liquid hydrocarbon middle distillate fuel oils having **boiling points from about 150 to 400°C.**" Specification, p. 1, ll. 5-7 (emphasis added).

New method claims 12 and 24 specify the use of a fuel blend, and new composition claim 36 specifies a fuel blend, comprising an amount of "Fischer-Tropsch derived gas oil comprising 95% w/w or greater components having boiling points of from about 150 to about 400°C"—the **boiling range of typical diesel fuels.** Specification, p. 2, l. 29, claims 12 and 21.

In contrast, Berlowitz' states that his "blend . . . provides a fuel having reduced sulfur levels and emissions levels lower than those predicted by standard correlations . . . by eliminating the heavy end of the conventional diesel fuel and **replacing the heavy end with a low sulfur Fischer-Tropsch derived diesel fuel boiling above the range of a normal diesel fuel.**" Berlowitz, col. 2 ll. 53-60 (emphasis added).

The examiner cannot point to a teaching or suggestion in Berlowitz of a method of reducing combustion related deposits in a diesel engine (claim 12) or removing combustion related deposits in a diesel engine (claim 24) using a diesel fuel blend comprising the claimed "Fischer-Tropsch derived gas oil comprising 95% w/w or greater components having boiling points of from about 150 to about 400°C." Nor can the examiner point to a teaching or suggestion in Berlowitz of a diesel fuel blend comprising the claimed "Fischer-Tropsch derived

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gas oil comprising 95% w/w or greater components having boiling points of from about 150 to about 400°C." Claims 21-27.

The examiner therefore cannot meet the "flexible TSM" test. *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc., et al.*, 86 U.S.P.Q.2d 1196, 1201-02 (Fed. Cir. 2008) (emphasis added), citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (reaffirming that "a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis"). Nor can the examiner establish that the claims are directed to merely "the predictable use of prior art elements according to their established functions." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385, 1396 (U.S. 2007) (emphasis added).

The examiner also cannot establish that Bacha provides an apparent reason to combine known elements in the fashion claimed. *Id.* (emphasis added).

Applicant respectfully requests allowance of new claims 12-42 over Berlowitz and Bacha.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests an extension of time to respond to the final action, entry of the Request for Continued Examination submitted herewith together with the new claims, and consideration and allowance of the new claims. The Commissioner is hereby authorized to charge any fee in connection with this paper to Deposit Account No. 19-1800 (File no. TS7607), maintained by Shell Oil Company

Respectfully submitted,

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